

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed February 5, 2004. Claims 1, 2, 8, 15, 20 and 23 are amended herein. Claims 1-29 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Claim Objections

The Examiner objected to claim 8 because of an informality. Specifically, at line 6 the Examiner required that “it” be replaced with --the confirmation projector--. Applicants have amended claim 8 to replace “it” with --the image processo --, instead of --the confirmation projector-- as requested by the Examiner. This amendment more accurately captures the function of the apparatus, since it is the image processor that signals to the confirmation projector that the image has been processed. Applicants respectfully submit that this overcomes the Examiner’s objection.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 6, 7, 10 and 13 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,330,974 to Ackley (“Ackley”). Applicants respectfully traverse the Examiner’s rejections. A claim is anticipated only if each and every element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As explained below, Ackley cannot anticipate these claims because it does not disclose every element and limitation recited therein.

Claim 1, as amended, recites an apparatus combination including a base capable of receiving a camera including a lens and a projector coupled to the base and adapted to project a plurality of beams of light onto a plane positioned at a focus distance from the base, wherein the projections of the beams of light on the plane are geometric shapes, and “wherein an intersection of the geometric shapes is at the center of the field of view of the lens independent of the distance between the lens and the plane” when the lens is installed on the base. Ackley cannot disclose a combination including the recited limitations. Ackley discloses that a pair of laser diodes 34 are used to project two beams of coherent light at an angle toward a symbol, thereby illuminating the symbol so that it can be read. The two beams of coherent light, however, intersect only at one point. At positions closer to or farther from the scanner 10 than the single

intersection point, the beams do not intersect at all. Ackley therefore cannot disclose, teach or suggest a combination “wherein an intersection of the geometric shapes is at the center of the field of view of the lens independent of the distance between the lens and the plane.” Applicants submit that the claim is therefore allowable, and respectfully request withdrawal of the rejection.

As to claims 6 and 7, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See, e.g.,* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicants submit that claims 6 and 7 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited in the claims. Applicants respectfully request withdrawal of the rejections and allowance of these claims.

Claim 10 recites a method combination including projecting a first light beam onto a plane, wherein the projection of the first light beam on the plane is a first geometric shape; projecting a second light beam onto the plane, wherein the projection of the second light beam on the plane is a second geometric shape; and aligning the first and second beams “such that an intersection of the first and second geometric shapes is at the center of the field of view of a lens of a camera, independently of the distance between the lens and the plane.” By analogy to the discussion above in connection with claim 1, Ackley does not disclose, teach or suggest a combination including these limitations. Applicants submit that the claim is therefore allowable, and respectfully request withdrawal of the rejection.

As to claim 13, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See, e.g.,* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 10 is in condition for allowance. Applicants submit that claim 13 is therefore allowable by virtue of its dependence on an allowable independent claim, as well as by virtue of the features recited in the claim. Applicants respectfully request withdrawal of the rejections and allowance of this claim.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 2-5, 8-9, 11-12 and 14-29 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, various combinations of the following references: Ackley, U.S. Patent No. 5,598,007 to Bunce et al (“Bunce”) and European Patent No. EP1128315 to Rigoni et al (“Rigoni”).

As to claims 2-5, 8-9 and 11-12 and 14, Applicants respectfully traverse the Examiner's rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 1 and 10 are neither anticipated nor obvious, and are therefore in condition for allowance. Applicant therefore respectfully submits that claims 2-5 and 8-9 are allowable by virtue of their dependence on allowable claim 1, as well as by virtue of the features recited therein. Similarly, claims 11-12 and 14 are allowable by virtue of their dependence on allowable claim 10, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

As to claims 15, 20 and 23, Applicants respectfully traverse the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 15 was rejected as obvious over Ackley in view of Rigoni. As amended, claim 15 recites an apparatus combination including a base capable of receiving a camera including a lens, an image processor capable of being coupled to the camera for processing an image of a target captured by the camera, and a confirmation projector coupled to the image processor, wherein "the projector projects a non-targeted confirmation beam onto the plane of the target when the image processor signals the confirmation projector that it has processed the image." The Examiner concedes that Ackley does not disclose a confirmation beam for confirming the processing of the image, but alleges that Rigoni discloses this feature. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ackley with Rigoni to arrive at the presently claimed invention. Applicants disagree. Rigoni discloses that a confirmation beam should be carefully targeted so that it is projected directly on and very closely around the symbol being read, where it is likely to capture the attention of the user. Rigoni therefore cannot disclose, teach or suggest a combination including a confirmation projector wherein "the projector projects a non-targeted confirmation beam onto the plane of the target when the image processor signals the confirmation projector

that it has processed the image.” Since the Examiner concedes that Ackley also does not disclose this element, the combination of Ackley and Rigoni cannot disclose every element and limitation of the claim and therefore cannot render the claim obvious. Applicants therefore respectfully request withdrawal of the rejection and allowance of the claim.

Claim 20 was rejected as obvious over Ackley in view of Rigoni. As amended, claim 20 recites a process combination including capturing an image of a target on a plane using a camera, processing the image captured by the camera using an image processor, and “projecting a non-targeted confirmation beam onto the plane when the image processor signals to the confirmation projector that the image processor has processed the image.” By analogy to the discussion above in connection with claim 15, Applicants submit that Ackley and Rigoni cannot render the claim obvious because, even when combined, they do not disclose every element and limitation of the claim. Applicants therefore respectfully request withdrawal of the rejection and allowance of the claim.

Claim 23 was rejected as obvious over Ackley in view of Rigoni. As amended, claim 23 recites an apparatus combination including a base capable of receiving an image processor and a camera including a lens and a projector coupled to the base and adapted to project a plurality of beams of light onto a plane positioned at a focus distance from the lens, wherein the projections of the beams of light on the plane are geometric shapes, and “wherein an intersection of the geometric shapes is at the center of the field of view of the lens independent of distance between the lens and the plane” when the lens is installed on the base. As discussed above, Ackley does not disclose, teach or suggest a combination including these elements and limitations. Rigoni also does not disclose, nor has the Examiner alleged that it discloses, these limitations. The combination of Ackley and Rigoni therefore cannot disclose every element and limitation in the claim. Applicants submit that Ackley and Rigoni therefore cannot render this claim obvious and respectfully request withdrawal of the rejection.

Regarding claims 16-19, 21-22 and 24-29, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 15, 20 and 23, as amended, are in condition for allowance. Applicants submit that claims 16-19 are therefore allowable by virtue of their dependence on allowable claim 15, as well as by virtue of the features recited

therein. Similarly, claims 21-22 are allowable by virtue of their dependence on allowable claim 20, as well as by virtue of the features recited therein, and claims 24-29 are allowable by virtue of their dependence on allowable claim 23, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.


Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 5-5-04


Todd M. Becker
Attorney for Applicant(s)
Registration No. 43,487

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025-1030
Phone: 206-292-8600
Facsimile: 206-292-8606

Enclosures: Postcard
Transmittal letter, in duplicate